

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. KROM and XIAORONG WANG

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2001-2478

Application No. 09/097,035

ON BRIEF

Before KIMLIN, WALTZ, and TIMM, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

REQUEST FOR REHEARING

Pursuant to the provisions of 37 CFR § 1.197(b) (2000),
appellants have submitted a Request for Rehearing (hereafter the
"Request") dated May 19, 2003, Paper No. 25, requesting rehearing
of our Decision dated Mar. 14, 2003, Paper No. 24 (hereafter the
"Decision"), where this merits panel of the Board affirmed the
examiner's rejection of claims 1-4, 6-10 and 13-14 under 35 U.S.C.

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§ 102(b) as anticipated by Coran (Request, page 1; Decision, page 4).¹

Appellants request rehearing based primarily on the issue of claim construction of the term "comprised substantially" (Request, pages 2-4). Appellants argue that the Board has construed this term as rendering the claim open to other ingredients, even in major amounts, while appellants urge that the word "substantially" modifies the well known meaning of "comprising" to give a more narrow claim construction (Request, pages 2 and 4).

Appellants' arguments are not persuasive for reasons set forth in the Decision at pages 5-7. We note that claim construction is a question of law based on underlying factual issues. See *In re Donaldson*, 16 F.3d 1189, 1192, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc). However, during prosecution of an application, the claim language must be given its broadest reasonable interpretation as it would have been understood by one of ordinary skill in the

¹As noted by appellants, the examiner's rejection of claims 1-4, 6-10, 13-14 and 21 under 35 U.S.C. § 103(a) over Berta in view of Stayer and appellants' admissions was reversed and forms no part of this Request (Request, page 2; Decision, page 4). We also note that contrary to footnote 1 on page 2 of the Decision, the examiner has still not had the amendment of Paper No. 19 entered in the file record. For purposes of this Request, we consider the record as if this amendment had been properly entered.

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art when read in light of the specification. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Appellants and the examiner have agreed on the well-known meaning of the transitional term "comprising" in patent jurisprudence (Answer, page 4; Reply Brief, page 2; Decision, page 6). We have also noted that the meaning of transitional terms such as "comprising," "consisting essentially of," and "consisting" is well settled in patent jurisprudence (Decision, page 6, and citations therein).

If appellants were attempting to exclude some subject matter from the claimed composition, they have had the opportunity during the prosecution of this application to employ "closed" or "intermediate" language such as "consisting" or "consisting essentially of" (see the Brief, page 8; Reply Brief, page 2; Decision, page 6). Additionally, we note that appellants are in a weak position to urge a restricted meaning for "comprising substantially" when their specification does not give any definition, limits or guidance as to the scope of this hybrid terminology (Decision, page 6, citing appellants' specification, page 2, ll. 31-33; page 3, ll. 2-8; and page 5, l. 21-page 6, l. 25). See *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) ("an applicant who has not clearly limited his claims is in a weak position to assert a narrow construction.") (Decision, sentence

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bridging pages 6-7). If appellants are attempting to use other than well defined transitional terms, we must look to the specification for some definition or guidance as to the meaning and scope of this terminology. See *AFG Industries, Inc. v. Cardinal IG Co.*, 239 F.3d 1239, 1244-45, 57 USPQ2d 1776, 1780-81 (Fed. Cir. 2001). Although appellants attempt to exclude the prior art (Coran) from the claimed subject matter, we note that appellants in their Request have not established what is encompassed by "comprising substantially" nor where in the original specification there is any definition, limits or guidance as to the scope of this transitional term.

For the foregoing reasons and those set forth in our original Decision, we have considered appellants' Request but we do not find in the Request any argument convincing us of error in the conclusions we reached in our Decision. Therefore appellants' Request for Rehearing is denied.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

Edward (Ken) L

EDWARD C. KIMLIN
Administrative Patent Judge

Thomas A. Waltz
THOMAS A. WALTZ
Administrative Patent Judge

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